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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,952	11/14/2003	Robert J. Greenberg	5793.3093-00	7773
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER UBER, NATHAN C	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 10/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,952

Applicant(s)

GREENBERG ET AL.

Examiner

NATHAN C. UBER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-8,11,15-18,21-26,33,36-41 and 43-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8,11,15-18,21-26,33,36-41 and 43-45 is/are rejected.
- 7) ☒ Claim(s) 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 10 June 2008.
2. Claims 1-3, 6-8, 11, 15-18, 21-23, 26, 30-33, 36-41 and 43-45 have been amended.
3. Claims 4, 5, 12, 19, 20, 27, 34, 35 and 42 have been canceled.
4. Claims 1-3, 6-8, 11, 15-18, 21-26, 38-33, 36-41 and 43-45 are currently pending and have been examined.

Specification

5. The disclosure was objected to because it contained embedded hyperlinks. Appropriate corrections were made, the objection is withdrawn.

Claim Objections

6. Claims 5, 19, 20 and 35 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The claims were canceled, therefore the objection is moot.
7. Claims 15, 30 and 45 are objected to because of minor informalities. Appropriate corrections were made, the objection is withdrawn.
8. Claim 37 is objected to because the amended claim now depends from claim 1, for the purposes of this examination Examiner interpreted this amendment as a typo and assumes that claim 37 was intended to depend from claim 31.

Claim Rejections - 35 USC § 112

9. Claims 1-3, 5-8, 11-12, 16-18, 20-23, 26-27, 31-33, 35-38, and 41-42 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 4, 5, 12, 20, 27, 35 and

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42 have been canceled, therefore the rejection is moot with regard to the canceled claims. With respect to claims 1, 2, 6-8, 11, 16-18, 21-23, 26, 31-33, 36-38 and 41, the claims were amended appropriately to overcome the 112 rejections, accordingly the rejections are hereby withdrawn.

Claim Rejections - 35 USC § 101

10. Claims 31-45 are rejected under 35 U.S.C. 101 because the claimed invention was directed to non-statutory subject matter. Applicant's amendments are satisfactory, the rejection is withdrawn.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1-3, 6-8, 11, 15-18, 21-26, 38-33, 36-41 and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall (U.S. 2002/0116266) in view of Walker et al. (6,018,718) and in view of **Official Notice**.

Claims 1, 16 and 31:

Marshall, as shown, discloses the following limitations:

- *detecting non-credit behavior of the customer, the detected non-credit behavior associated with and benefiting an enterprise* (see at least ¶0031, "...individuals accumulate time points by engaging in activities specified by the programs..." and ¶0035, "...such activities may include... attending in person or remotely sales presentation, providing blood donations... engaging in volunteer activities, or a range of other activity which may be desired"),
- *determining a reward associated with the financial account for the customer based on the detected non-credit behavior* (see at least ¶0031, "[a]n account associated with the individual is provided with accumulated time points when a desired activity is performed" see also ¶0005, describing a lack of incentive for early credit card account payments in the prior art, and ¶0006 calling for incentives for "desirable behaviors" such as early payments to credit card accounts),
- *receiving an acceptance of the offer from the enterprise, the acceptance including contact information of the customer* (see at least Figure 2, Item 215 shows the participant transmitting the customer's information to the system and Item 225 shows a third party transmitting the customer's information to the system, participants are shown transmitting necessary information to the system and thereby functionally demonstrating their acceptance or acquiescence to the offer; Examiner interprets willingness to participate as acceptance and interprets the transmission of necessary information as a demonstration of that willingness/acceptance),
- *soliciting, based upon the contact information, the customer to open the financial account* (see at least ¶0113, "[i]f the program determines that the

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individual is not an existing enrolled member, the individual is offered the option of enrolling in the program...”),

- *opening the financial account based upon a response to the solicitation* (see at least ¶0113, the individual/customer enrolls in the program by transmitting necessary enrollment information),

Examiner interprets *a reward associated with financial account* as described in ¶¶038-039 which explains that a reward or benefit may directly or indirectly affect an account and may comprise non-monetary units such as points or frequent flyer miles that accumulate in a *bucket*.

- *notifying the customer of the determined reward* (see at least Figure 7, item 800, “listing of various rewards are made available to individual”),

Marshall does not fully disclose *a financial account* as contemplated in ¶¶038, *a credit card account, a financial loan, a checking account, a savings account, or a stock fund*, however, Walker, as shown, more fully discloses a method of awarding particularly financial accounts:

- *financial account* (see at least column 1, lines 5-6),

Although Marshall discloses acceptance in Figure 2 (as shown above), where participants are shown transmitting necessary information to the system and functionally demonstrating their acceptance or acquiescence to the offer (Examiner interprets willingness to participate as acceptance and interprets the transmission of necessary information as a demonstration of that willingness/acceptance), Marshall does not specifically disclose making an offer as in the limitation below:

- *making an offer to the enterprise, the offer comprising offering to provide the benefit to the financial account in exchange for the customer engaging in the non-credit behavior*

Of course, if a participant can accept an offer (as shown) she must first have received an offer. Examiner takes **Official Notice** that it is old and well known in the art that business

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entities or service providers seeking to enter business relationships with other entities or attract participants accomplish this goal, at least initially, by presenting an offer to the perspective participant, such an offer detailing the nature of the business venture proposed.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine (1) the financial account reward method of Walker with the reward system of Marshall and (2) to offer the services of the Marshall invention to perspective participants because (1) Marshall suggests that service providers such as credit card companies and utilities could benefit from desirable behaviors such as early account payments (see ¶005) and Walker enables a method for applying such rewards program to such accounts and because (2) without participants the service won't benefit anyone and the administrator of the Marshall invention is in a better position to make the initial offer/contact because they conduct the methods and systems of the invention and perspective participants may not otherwise know the service exists.

Claim 2, 17 and 32:

The combination Marshall/Walker discloses the limitations in the rejections above. Marshall further discloses evaluating the account balance of a customer to determine eligibility for a reward (see at least ¶0097). Marshall does not disclose the following limitation, however, Walker, as shown, does:

- *evaluating a credit risk of the financial account based upon a frequency at which the non-credit behavior is detected (see at least column 7, lines 34-36, scores are "currently" used to determine the credit risk of a customer),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use to the methods disclosed by Walker to be generally known in the art (i.e. evaluating the credit risk of customers based on non-credit behavior such as replying to advertisements) to obtain information about a customer because Marshall teaches providing meaningful incentive to customers to try to influence desirable *non-credit*

behavior and being able to predict a customers actions based on Walker's scores helps one practicing the Marshall invention to develop meaningful incentives for the customer and perhaps avoid customers that are not desirable.

Claim 3, 18 and 33:

The combination Marshall/Walker discloses the limitations in the rejections above. Further, Marshall, as shown, discloses the following limitations:

- *if the frequency at which the non-credit behavior is detected attains a certain threshold, providing for the financial account at least one of (see at least ¶0095, "threshold levels create tangible reward thresholds that individuals can strive to reach in order to become entitles to select a specific reward offered..."),*
- *a waiver of an annual fee, a credit redeemable for products, and a credit redeemable for services (see at least ¶0015, discounted services, and ¶0031, "time points may be redeemed for products and/or services..."),*

Marshall does not disclose the following limitations, however, Walker, as shown, does:

- *an interest rate lower than an interest rate of the financial account prior to the evaluation, a credit limit higher than a credit limit of the financial account prior to the evaluation, a monetary credit (see at least column 9, Table II),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the rewards of Walker with the rewards of Marshall because Marshall teaches providing meaningful incentives to customers.

Claim 6, 21 and 36:

The combination Marshall/Walker discloses the limitations in the rejections above. Further, Marshall, as shown, discloses the following limitation:

- *the determined reward for the financial account at least one of a waiver of an annual fee, a credit redeemable for products, and a credit redeemable for*

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services (see at least ¶0015, discounted services, and ¶0031, "time points may be redeemed for products and/or services..."),

Marshall does not disclose the following limitations, however, Walker, as shown, does:

- *an interest rate lower than the interest rate prior to the evaluation, a credit limit higher than the credit limit prior to the evaluation, a monetary credit (see at least column 9, Table II),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the rewards of Walker with the rewards of Marshall because Marshall teaches providing meaningful incentives to customers.

Claim 7, 22 and 37:

The combination Marshall/Walker discloses the limitations in the rejections above.

Further Marshall, as shown, discloses the following limitations:

- *associating the financial account with the enterprise if the customer is currently a customer of an institution controlling the financial account based upon the contact information (see at least ¶0113, "[t]he information is received by the system and evaluated by the software program to determine whether the individual is an existing enrolled member"),*

Claim 8, 23 and 38:

The combination Marshall/Walker discloses the limitations in the rejections above.

Marshall, as shown, further discloses the following limitation:

- *receiving a voucher subsequent to a performance of the non-credit behavior (see at least Figure 5, Items 600 and 635, participant system records individual accumulation session values and sends them to the program administrator).*

Claim 9, 24 and 39:

The combination Marshall/Walker discloses the limitations in the rejections above.

Marshall, as shown, further discloses the following limitation:

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- *receiving the voucher from the enterprise* (see at least Figure 5, Items 600 and 635, participant system records individual accumulation session values and sends them to the program administrator).

Claim 10, 25 and 40:

The combination Marshall/Walker discloses the limitations in the rejections above. Marshall, as shown, further discloses methods and a system equivalent to the limitation below:

- *receiving the voucher from the customer* (see at least ¶0075, explaining (with reference to Item 180 of Figure 1) how customers that are not previously enrolled are presented with a unique code that identifies their participation in a credit-worthy activity, the customer then provides this code to the program administrator during enrollment to obtain the credit earned, see also Figure 11, particularly Item 1340, in which individuals initiate accumulation sessions/activities on their own by accessing the system, see also ¶0072, describing a checkpoint system that individuals activate to alert the system of their presence/behavior).

Claim 11, 26 and 41:

The combination Marshall/Walker discloses the limitations in the rejections above. Marshall, as shown, further discloses methods and a system equivalent to the limitation below:

- *receiving an electronic file subsequent to a performance of the non-credit behavior* (see at least Figure 5, Items 600 and 635, participant system records individual accumulation session values and sends them to the program administrator),
- *the electronic file comprising a description of the non-credit behavior and an identification of the customer, the identification of the customer obtained by reading an indicia presented by the customer* (see at least ¶0074, individuals

provide identification information to the participant electronically, and it is recorded by the system and stored along with a record of the task completed and any previously completed and recorded tasks, see also ¶0054 "the system may issue the individual a unique alphanumeric identification code...").

Claim 13, 28 and 43:

The combination Marshall/Walker discloses the limitations in the rejections above.

Further, Marshall, as shown, discloses the following limitation:

- *using at least one of e-mail, voice mail, facsimile, mail, an item delivery service, Internet, telephone, diskettes, CD ROM, and an interactive voice response system (IVR) (see at least ¶0060, telephone interactions and internet interactions).*

Claim 14, 29 and 44:

The combination Marshall/Walker discloses the limitations in the rejections above.

Marshall does not disclose the following limitations, however, Walker, as shown, does:

- *the financial account comprises at least one of a credit card account, a financial loan, a checking account, a savings account, and a stock fund (see at least column 3, line 17, the preferred embodiment of this invention is a credit card account),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the financial account reward method of Walker with the reward system of Marshall because Marshall suggests that service providers such as credit card companies and utilities could benefit from desirable behaviors such as early account payments (see ¶005) and Walker enables a method for applying such rewards program to such accounts.

Claim 15, 30 and 45:

The combination Marshall/Walker discloses the limitations in the rejections above.

Further, Marshall, as shown, discloses the following limitation:

- *the enterprise comprises at least one of a charity, a religious organization, a civic club, a professional organization, a school, a university, a sports organization, a political organization, a government agency, a private corporation, and a public corporation (see at least ¶0035, describing various examples of participants including blood donor organizations, utility providers, and other service providers like prepaid phone providers).*

Response to Arguments

14. Applicant's arguments filed 10 June 2008 have been fully considered but they are not persuasive. Applicant amended the independent claims to include limitations from claims 5, 20 and 35. One such limitation was rejected under Marshall in view of official notice. Applicant attempted to traverse Examiner's official notice. Applicant argues the following:

"the recitations recited in claim 1 are not unquestionably well-known, and the Examiner has failed to demonstrate the contrary... [f]urther, Applicant's submit that 'providing an offer to the enterprise, the offer comprising an offer to provide the reward to the financial account for the customer in exchange for the customer to further engage in the non-credit behavior,' in the context of managing a financial account, as recited in claim 1, is not well known" (pp 19).

Examiner directs Applicant's attention to MPEP §2144.03(C) reproduced in part below:

To adequately traverse [a finding of official notice], an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.").

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Here Applicant failed to adequately traverse the official notice because Applicant neither specifically pointed out the supposed errors in the examiner's action nor why the official notice is not considered common knowledge.

15. Examiner took official notice "that it is old and well known in the art that business entities or service providers seeking to enter business relationships with other entities or attract participants accomplish this goal, at least initially, by presenting an offer to the perspective participant, such an offer detailing the nature of the business venture proposed." Applicant neither indicated where Examiner erred in this finding, nor why Applicant disagrees with this finding. Examiner maintains this finding. Further Examiner maintains that this finding of official notice adequately addresses Applicant's limitation "providing an offer to the enterprise." Examiner notes that the remaining portion of the limitation in question, "the offer comprising an offer to provide the reward to the financial account for the customer in exchange for the customer to further engage in the non-credit behavior" was not given patentable weight because the content of a given offer does not patentably affect the scope of the claim. Accordingly, per MPEP §2144.03(C), the official notice is taken to be admitted prior art because applicant's attempted traverse was inadequate.
16. Applicant moved a second limitation from claims 5, 20 and 35 into the independent claims and argues the following:

"[a]s further disclosed by *Marshall*, profile information of customers enrolling in the program may be 'forwarded by a third party to a program administrator' (*Marshall*, ¶0080) [h]owever, as recited in claim 1, the acceptance of the offer is received from 'an enterprise' and not 'a program administrator' [n]owhere does *Marshall* teach or suggest receiving an acceptance of the offer from 'an enterprise'... the 'program administrator' of *Marshall* does not equate to the claimed 'enterprise'" (pp 20).

17. As Applicant demonstrated, *Marshall* discloses the receipt of an acceptance. From whom the acceptance is received does not patentably affect the scope of the claims and was not afforded patentable weight. Further Examiner draws Applicant's attention to Examiner's rejection and the *Marshall* art in which a 'third party' is also depicted as accepting the offer by transmitting

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customer information. A third party, like a program administrator, *is* equivalent to an enterprise absent any special definitions in the specification that teach otherwise. Therefore Examiner maintains that the following limitation: *receiving an acceptance of the offer from the enterprise, the acceptance including contact information of the customer*, is addressed by Marshall, Figure 2, Item 215 depicting the participant transmitting the customer's information to the system and Item 225 depicting a third party transmitting the customer's information to the system. Participants are shown transmitting necessary information to the system and thereby functionally demonstrating their acceptance or acquiescence to the offer. Examiner interprets willingness to participate as acceptance and interprets the transmission of necessary information as a demonstration of that willingness/acceptance.

Conclusion

18. Having responded to all of Applicant's arguments, Examiner does not find any allowable matter in foregoing claims and the claims remain rejected as detailed above. The previous rejections were maintained. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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20. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
22. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

23. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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401 Dulany Street
Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622
7 October 2008

/Arthur Duran/
Primary Examiner, Art Unit 3622